

REMARKS

Telephonic Examiner Interview

On February 25, 2010, Examiner LeRoux, the undersigned, and Michael J. Swope (Reg. No. 38,041) conducted a telephonic interview. Claim 1 was discussed. No agreement was reached.

On February 26, 2010, Examiner LeRoux contacted the undersigned for a telephonic interview in which Examiner LeRoux discussed a new reference that has not been previously applied in this application. Applicants have not considered the applicability of this reference in the present response.

Applicants' representative is available for further discussion, and may be reached via telephone at (206) 903-2467.

Claim Rejections – 35 USC § 103

Claims 1, 6-8, 20, 24-27, 33, 35, 40, 41, and 43 stand rejected under 35 USC § 103(a) as being unpatentable over Enari (Pat. No. 6,747,998) in view of Petteruti et al. (Pat. No. 6,411,397).

Claim 1 recites, "writing the unique volume label to a storage portion of the storage medium." In the present Office Action, the Office is silent as to this language, so has not stated how Enari in view of Petteruti teaches this element. MPEP 2143.03 requires the Office to demonstrate that a combination of references teaches every element claimed in order to meet its burden under 35 U.S.C. §103 :

"All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Because the Office Action is silent as to this language, applicants respectfully submit the *prima facie* case of obviousness has not been established.

Claim 1, as amended, recites, "updating a database with an association between each file stored on the storage medium and a value associated with the unique volume label." (the

deleted language is omitted). Support for this amendment is found in at least original claim 9.

Claim 1, as further amended, recites, “in response to determining that a first file contained on the storage medium has been deleted, updating the database to reflect that the first file has been deleted.” Support for this amendment is found in at least paragraph [0049] of the specification.

Applicants respectfully submit that Enari in view of Petteruti does not teach this amended claim language.

In view of the foregoing analysis, applicants respectfully submit that the combination of Entari and Petteruti fail to render obvious claim 1. Additionally, applicants respectfully submit that dependent claims 2-4, 6-14, 40, and 43 are in condition for allowance for at least the reasons that claim 1 is in condition for allowance.

Claim 20 makes substantially similar recitations as claim 1, and the Office has rejected claim 20 using the same rationale as used to reject claim 1. Applicants respectfully submit that claim 20 is not rendered obvious by Entari in view of Petteruti for at least the similar reasons as those analyzed with respect to claim 1, *mutatis mutandis*, as are dependent claims 21-34, and 41.

Independent claim 35 stands rejected under the same rationale as used to reject claim 1. In making these two rejections with specificity, the Office recites only language found in claim 1. However, claim 35 has markedly different language.

For instance, the recitation, “a user input device for accepting at least one search parameter from a set, the set comprising: file name, file size, file author, and file type,” appears in claim 35 as presented, but no such limitation appears in claim 1. As such, applicants respectfully submit that the Office has not met the burden of MPEP 2143.03 by not articulating that the combination of references teaches every element claimed.

However, applicants submit that perhaps the Office intended to articulate that claim 35 stands rejected under the same rationale as used to reject claim 15 (discussed below). If this is the correct, then applicants respectfully submit that claim 35 is in condition for allowance for the same reasons that claim 15 is in condition for allowance, *mutatis mutandis*.

Thus, applicants respectfully submit that claim 35 is in condition for allowance as are dependent claims 36-39.

Claims 2, 3, 10-17, 19, 21-23, 29-32, 34, 36, 37, 39, and 42 stand rejected under 35 USC § 103(a) as being unpatentable over Enari in view of Petteruti et al. and further in view of Haneda (Pat. No. 6,243,171).

Claim 15, as amended, recites, “determining an external storage medium, the label being affixed to an external portion of the external storage medium.” Support for this amendment is found in least paragraph [0023].

Claim 15, as amended, further recites, “accepting at least one search parameter from a set, the set comprising: file size, file author, and file type.” The Office states that this language is taught by Haneda at col. 22, lines 5-20. Applicants respectfully submit that the “film image file” disclosed in that citation of Haneda teaches neither file size, file author, nor file type, and thus does not teach a “set comprising: file size, file author, and file type,” as claimed.

Thus, applicants respectfully submit that claim 15 is in condition for allowance as are dependent claims 16-19, and 42.

For reasons previously articulated, applicants respectfully submit that claims 2, 3, 10-14, 21-23, 29-32, 34, 36, 37, and 39 are in condition for allowance.

Claims 9 and 28 stand rejected under 35 USC § 103(a) as being unpatentable over Enari in view of Petteruti et al. and further in view of Pond et al. (Pat. No. 4,864,616).

Applicants submit that claims 9 and 28 are in condition for allowance for at least the reasons that respective independent claims 1 and 20 are in condition for allowance.

Claims 18 and 38 stand rejected under 35 USC § 103(a) as being unpatentable over Enari in view of Petteruti et al., further in view of Haneda, and further in view of Raistrick et al. (Pat. No. 5,971,279).

Applicants submit that claims 18 and 38 are in condition for allowance for at least the reasons that respective independent claims 15 and 35 are in condition for allowance.

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PATENT

CONCLUSION

In view of the above remarks, applicants respectfully submit that the present final rejection be withdrawn, and that a Notice of Allowance be issued for this application.

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